REMARKS

Claims 1-8 and 79 are pending in the application. In order to more clearly define the invention, claims 88-119 have been added. Support for new claims may be found in original claims as filed. No new matter has been added.

The Office Action has maintained the rejection of these claims under the doctrine of obviousness-type double patenting, as being unpatentable over co-pending Application No. 10/632,950 (Div of 10/032,392). The Office Action states that USSN 10/632,950 teaches the generic compounds and compositions having similar variable substitutions which are within the boundaries of the instantly claimed compounds and compositions, and therefore one skilled in the art would be motivated to choose to replace variable substitutions. The Office Action further states that the compounds are so closely related structurally to the homologous and/or analogous compounds of the cited art as to be structurally obvious. The Office Action concludes that in the absence of any unobviousness or unexpected properties, the obviousness-type double patenting is deemed to be proper.

This rejection is respectfully traversed. Applicants assert that the Office Action has failed to make a *prima facie* case of obviousness. The principle that an earlier genus patent does not necessarily render obvious a subsequent claim to a species or subgenus of the genus is well-grounded in the law of double patenting. See In re Baird, 16 F.3d 380, 29 USPQ 2d 1550 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.").

In addition, the similarity in the compounds is not predicative of the properties of the compounds. Chemistry is inherently unpredictable, chemical compounds are unique, and minor changes often lead to substantially different and surprising results. See In re Soni, 54 F.3d 746, 750 (Fed.Cir.1995); accord Donald S. Chisum, Chisum on Patents, § 5.04[6] (2000). The mere structural similarity of the chemical compounds is insufficient for a prima facie showing of obviousness because chemicals must be assessed with their respective properties. In re Papesch, 315 F.2d 381, 391 (C .C.P.A.1962); accord In re Huellmantel, 324 F.2d 998, 1003 n .3 (C.C.P.A.1963).

In claim 1 of the '950 patent application, the definition of Z has been amended to S.. In claim 1 of the present application, the definition of Z has been amended as follows:

> "Z represents NR^b, where R^b is hydrogen, or substituted or unsubstituted (C_1-C_6)alkyl, (C_2-C_6)alkenyl, (C_3-C_6)cycloalkyl, (C_1-C_6)alkoxy, aryl, aralkyl, aryloxy, (C_1-C_6)alkylcarbonyl, arylcarbonyl, (C_1-C_6) alkoxycarbonyl and aryloxycarbonyl;"

It is not obvious from the claims of the '950 application that Z can be defined as in the present application. In conclusion, the compounds of the present application are not obvious over the compounds of the '950 application and no finding can be made that one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a hole, i.e., to select the claimed species or subgenus from the disclosed prior art genus. The Office Action has thus failed to make *prima facie* case of obviousness. Therefore, the obviousness-type double patenting is deemed to be improper and Applicants request that this rejection be withdrawn.

In view of the foregoing remarks, Applicants submits that the pending claims particularly define and patentably distinguish the invention over the art of record, and request that the Rejection be withdrawn and that this case is passed to issuance. Should the Office believe that further issues remain to be resolved it is requested that she

telephone the undersigned in order to provide the Applicants with an opportunity to resolve such issues.

Respectfully submitted,

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Date

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